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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/599,674

06/22/2000

Brian J. Brown

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7508

490

7590

07/30/2002

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/599,674

Applicant(s)

BROWN ET AL.

Examiner

Paul B. Prebilit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it contains a grammatical error. On line 3 of the abstract, "connector" should be changed to either —a connector— or —connectors— in order to not be grammatically awkward. Correction is required.

See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In particular, it is not seen where the claim language (claim 9) "the first type or set of strut members having a shorter total circumferential length as compared to the total circumferential length of the second type of set of strut members" has original support. In particular, Applicant at least did not recognize this characteristic, and it was not considered to have been originally contemplated.

Claims 9-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the language of the claims lacks clear

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antecedent basis from the specification such that it is not clear what structure of element of the specification corresponds to the structure or element of the claims.

In particular, the circumferential length is a measure of the length along a circle running along a radial arc. This radial arc, in the present case and in a cylinder in general, would be perpendicular to the longitudinal axis of the cylinder. Therefore, the circumferential length is across the width of the struts. For this reason, the circumferential lengths of all the circumferential sections in Figure 4 are the same.

However, the struts of the claimed and disclosed invention are longitudinally not circumferentially oriented. Therefore, it is the longitudinal length not the circumferential length of the struts that vary in Figure 4. For this reason, it appears that Applicant have used "circumferential length" in manner that is contrary and possibly repugnant to its accepted meaning in the art. Moreover, there is no redefinition of the terminology "circumferential length" to include length along a longitudinal direction as well. For this reason, the claim language is considered indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 9-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Moriuchi (US 6,013,854). Referring to Figures 5 and 6, Moriuchi anticipates the claim language where the first type or set of strut members as claimed are in the center section (103) of Moriuchi and the second set as claimed are the proximal and distal sections (104) of Moriuchi and at least two of these struts are longer than the others of the stent; see element 113 and the strut immediately adjacent thereto.

With regard to claim 12, it is the Examiner's position that since the stent of Moriuchi is capable of being mounted on a balloon and capable of even elastic expansion with a balloon that the claim language is fully met.

Claims 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Cardon et al (EP 0541443; see US 5,383,892 for an English translation thereof). Cardon et al anticipates the claim language wherein the center section thereof has longer struts that are easier to compress radially than the struts of the end; see the whole document.

Response to Arguments

Applicant's arguments filed May 20, 2002 have been fully considered but they are not persuasive.

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In response to the argument that the variable circumferential length has support from Figure 4, the Examiner posits that Applicant may have a confusing manner of claiming the invention. In particular, the circumferential length is a measure of the length along a circle running along a radial arc. This radial arc, in the present case and in a cylinder in general, would be perpendicular to the longitudinal axis of the cylinder. Therefore, the circumferential length is across the width of the struts. For this reason, the circumferential lengths of all circumferential sections in Figure 4 are the same.

However, the struts of the claimed and disclosed invention are longitudinally not circumferentially oriented. Therefore, it is the longitudinal length not the circumferential length of the struts that vary in Figure 4. For this reason, it appears that Applicant have used "circumferential length" in manner that is contrary and possibly repugnant to its accepted meaning in the art. Moreover, there is no redefinition of the terminology "circumferential length" to include length along a longitudinal direction as well.

In traversing the Section 102 Moriuchi rejection, Applicant argues that the stent thereof is not closed because it is a helical structure. The Examiner disagrees and asserts that the stent thereof is closed to the extent required by the claim language because it forms a cylinder; see Figure 5.

Applicant also traverses the Moriuchi rejection by arguing that element (113) is a strut and connector and not just a strut. In response, the Examiner posits that one of the elements (113) can be called a strut and the other called a connector; see the right side of Figure 6.

Next, Applicant traverses the Moriuchi rejection by arguing that the increased flexibility would have been caused by the increased length would have been identified by Moriuchi. However, the Examiner posits that this is not necessary for anticipation. Inherent features or properties can be used to find claims unpatentable. Furthermore, the claim language of the present application does not identify the strut length as the reason for the increased flexibility.

In traversing the Cardon Section 102 rejection, Applicant argues that Cardon lacks two types of strut members because the wires of the middle section are not struts in their view. In response, the Examiner asserts that this is an unreasonable interpretation of Cardon and the wires thereof. Certainly, the wires of Cardon are struts because they have a longitudinally supportive function.

Next, Applicant argues that the wires of Cardon do not form a "closed circumferential structure." However, the Examiner asserts that the closed structure is clearly shown in Figures 1 and 2 where the cylinder is the closed circumferential structure. For this reason, the arguments leveled against Cardon are considered unpersuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned problem is corrected.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic
Primary Examiner
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